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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/642,242 08/17/00 ANDRYSEK

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EXAMINER

LUKTON, D

ART UNIT

PAPER NUMBER

1653

DATE MAILED:

06/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/642,242

Applicant(s)

Andrysek

Examiner

David Lukton

Art Unit

1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Jan 8, 2001

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-32 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims 1-32 are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

Restriction to one of the following inventions is required under 35 U.S.C. §121:

- I. Claims 1, 6, 8, 10, 13, 15, 17, 20, 22, 24, 26, 28, drawn to a method of increasing viscosity.
- II. Claims 2, 25, 27, 29, 31, drawn to a composition that does not require the presence of alcohols.
- III. Claim 30, drawn to a composition that comprises the ingredients of the Group II, together with other specific compounds
- IV. Claims 3, 5, 7, 9, 11, 12, 14, 16, 18, 19, 21, 23, 32, drawn to a composition that requires the presence of alcohols.

Claim 4 is not grouped; claim 4 is drawn to a method, whereas claim 3 is drawn to a composition. In the event that claim 4 is amended so that it is properly subgeneric to another claim, it will be grouped appropriately.

The claimed inventions are distinct.

Groups II and IV are distinct. First, they are distinguished by the requirement in claim 3 that an alcohol be present. This is not required by claim 2. In addition, claim 3 recites the following (part (c)): "gel-creating substances selected from ... and/or unsaturated fatty alcohols". Thus, part (c) of claim 3 can be interpreted as not requiring "polyglycerol esters" at all.

Claim 30 has been sequestered from Group II. While claim 30 does not currently recite any specific components, applicants may amend claim 30 to recite such, in which case a new search would be required. However, in the event that Group II is elected, and claims therein found allowable, it is likely that novelty would accrue to claim 30, provided that claim 30 retained the limitations of the Group II claims. In such a case, claim 30 would likely be rejoined with Group II.

Groups I and II are regarded as distinct at this point. While Groups II and I are neither related as "product and process of use", nor as "product and process of making", it is still likely the case that, in the event Group II were elected, and claims therein found allowable, novelty would accrue to Group I claims, provided that Group I claims retained the limitations of the Group II claims. In such a case, it is likely that Group I would be rejoined with Group II.

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

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In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect the following species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable:

- a) a specific "hydrophobic active ingredient";
- b) a specific "polyglycerol ester", including a value of "n" (degree of polymerization) and whatever "R" groups may be present; currently, the independent claims permit, but do not require, the presence of two different "polyglycerol esters" [i.e., there is overlap between component (b) and component (c)]. The description of the elected specie should include a statement as to whether two different "polyglycerol esters" must be present, or whether there can be just one; In the event that Group IV is elected, a specific "gel creating substance" corresponding to part (c) of claim 3 should be elected.
- c) a specific mixture corresponding to part (d) of claims 1, 2 or 3 (triglyceride macogol glycerol esters, partial glycerides, fatty acids, macrogol esters of fatty acids, etc.).

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.



Serial No. 09/642,242
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1800